

of the group fail to "share a common utility" and fail "to share a substantial structural feature disclosed as being essential to that utility".

This rejection is traversed. Applicants maintains that the Markush groups previously submitted in each of independent claims 1 and 6 were consistent with established patent practice and are consistent with, for example, MPEP §803.02.

Applicants submit that the Markush group is sufficiently few in number that a search and examination of the entire claim can be made without serious burden. Also, Applicant asserts that all the members share a common utility. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. §103

The Examiner rejected claims 1-10 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,856,219, issued to Severence et al., ("*Severence*") in view of U.S. Patent No. 5,424,006 issued to Murayama et al. ("*Murayama*"). Applicant traverses the rejection.

Severence discloses a fishing float coated with a luminescent material. See Abstract.

Murayama discloses luminescent indicators for fishing bouys. See col.22, lines 6-7.

In contrast, the present invention is directed to a bouy cap where substantially the entire cap is phosphorescent.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

- (1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings.
- (2) There must be a reasonable expectation of success.
- (3) The prior art references must teach or suggest all the claim limitations.

See In re Vaeck, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143 et seq. The prior art references do not teach or suggest all the claim limitations. Specifically, bouy caps are not taught or suggested by the cited references. Also, motivation to combine and a reasonable expectation of success is also lacking. Accordingly, Applicants assert that a *prima facie* case of obviousness has not been established. Reconsideration of the rejection is respectfully requested.


Conclusion

Should the Examiner feel a telephone interview would be helpful in advancing this case to allowance, Applicants invite the Examiner to contact their representative at the number listed below.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Dated: 1-23-02

By: 
Brian C. Whipps
Reg. No. 43,261

